



Paper No. 6
COPY MAILED

MAY 01 2002

OFFICE OF PETITIONS

Milbank, Tweed, Hadley & McCloy LLP
1 Chase Manhattan Plaza
New York NY 10005-1413

In re Application of
Wise, *et al.*
Application No. 09/817,439
Filed: March 26, 2001
For: SYSTEM AND METHOD FOR
ESTIMATING CONDUIT LIQUIDITY
REQUIREMENTS IN ASSET BACKED
COMMERCIAL PAPER

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(b)

This is in response to the January 8, 2002 petition under 37 C.F.R. §1.47(b).

Petition History

This application was filed on March 26, 2001. However, the application lacked a declaration signed by the inventor as required by 35 U.S.C. §25, 35 U.S.C. §115, 37 C.F.R. §1.63, and 37 C.F.R. §1.68. Accordingly, the Office of Initial Patent Examination (hereinafter "OIPE") mailed a notice to file missing parts of nonprovisional application (hereinafter "notice") to the address of record on May 3, 2001. The notice requested a signed declaration and set a two month period for replying. A copy of this petition was then received by the office on January 8, 2001. The petition included a request for a four month extension of time, which with the certificate of mailing dated October 26, 2001, was timely.

THE RULE

37 C.F.R. §1.47

- (a) ...
- (b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

ANALYSIS

A review of the rule above shows that a grantable petition under 37 C.F.R. §1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage.¹

¹ See 37 C.F.R. §1.47 "Filing when an inventor refuses to sign or cannot be reached."

Petitioner has failed to satisfy requirements one (1) and five (5) above.

Proof that the non-signing inventors cannot be reached or refuse to sign the oath or declaration.

Before a refusal to sign can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, the address of the nonsigning inventor's attorney.² No showing of delivery of the application papers to the inventor has been made. Rather, all that has been alleged or shown is that a declaration and assignment papers were mailed to the inventors. Of course, before signing a declaration stating that one has read and understood the contents of the application, it is necessary that one be actually presented with a copy of the declaration to review. The papers in this instance, as delivered to the inventors, could not be truthfully signed because the inventors had not been given an application to review. Accordingly, the inventors have not refused to sign after being given an opportunity to review the application within the meaning of 37 C.F.R. §1.47.

Furthermore, as to inventor Pellegrini, the showing consists of a copy of the letter sent to his last known address coupled with a certified return receipt form and a copy of the envelope, marked with a USPS stamp reading that the letter was unclaimed. It is noted that the stamp used on the envelope has an option that the postal delivery man could have used to indicate refusal of delivery; that option was not marked. Thus, it is not clear whether Mr. Pellegrini refused delivery or simply was not home at the time that the letter was delivered. Further attempts are warranted.

Proof of proprietary interest.

The Manual of Patent Examination Procedure (hereinafter "M.P.E.P.") explains that when an application is treated under 37 C.F.R. §1.47(b), it must be proved that as of the date of filing:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.³

No showing has been made that any of the three above-cited conditions exists. An unsigned copy of the Applicant's "Worldwide Rules" has been included with this petition. These rules appear to assign to Applicant inventions conceived or developed during the course of employment. Additionally, in a declaration by Andrew N. Cadel, it is alleged that each of the inventors acknowledged receipt of these rules and of an intent to abide by them. However, no evidence is submitted of the inventors assent to these rules. Copies of the alleged assent to them that Mr. Cadel attests to are requested upon reconsideration.

² M.P.E.P. §409.03(d) "Proof of Unavailability or Refusal"

³ M.P.E.P. §409.03(f)

Therefore, *this petition is **dismissed***.

Petitioner is given TWO MONTHS from the mailing date of this decision to respond, correcting the above-noted deficiency. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

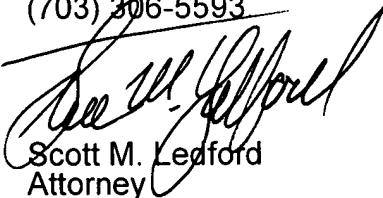
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at
(703) 306-5593



Scott M. Ledford
Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy